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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/019,574 | 05/03/2002 | Dirk Marinus Koenhen | USP165438 | 1644 |

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EXAMINER

LONEY, DONALD J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1772

DATE MAILED: 04/30/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/019574

Applicant(s)

Koenhen

Examiner

D. Loney

Group Art Unit

1772

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-20 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-20 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☒ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 1
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

1. A new substitute page 5 of the specification is required since the one supplied by the applicant has a number at line 24 pertaining to the WO document that is illegible.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is unclear as to the scope of "strong coagulation" and "mild coagulation". These are relative terms and will be treated so by the examiner.

In claims 4, 11 and 12, lines 1 to 2 there is no direct antecedent basis for "the channel side". Claim 1 recites channel within the membrane, not on a side. Claims 4, 11 and 12 also contain the term "additional" which is in parenthesis that should be deleted since it is unclear if this is part of the claim or not.

In claims 7 and 20 a membrane "without channels" is recited wherein the claim from which it depends contains channels. Clarification is kindly requested.

In claim 9, a spiral wound element is recited, however in line 1 a flat membrane is recited. This appears to be in direct contrast to one or other. Clarification is kindly requested.

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In claims 6, 16, 17, 18, 19 the recitation of "has no or hardly any resistance against liquid flow" is deemed vague and indefinite since one can not determine the scope thereof. This is also deemed a relative term in nature.

Claims 7 (as on amended sheet) and claim 20 are identical in scope (i.e., duplicates).

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

5. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6, 7, 16, 17, 19 and 20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Padovani.

Padovani teaches a multiple channel structure (21) with recesses formed at fin (29). Refer to Fig. No. 2. The channel has air in it which can be considered the active material in its broadest sense since no specific material recited. It

must be emphasized with product by process claims that it is the patentability of the product that is in issue, not the patentability of the process steps employed to prepare said product. See *In re Fessmann*, 180 USPQ 324 and *In re Brown*, 173 USPQ 685. Also see MPEP section 2113.

8. Claim 8 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Barnett.

Barnett teaches a cylindrical member with channels as recited. Refer to Fig. Nos. 5 or 6. Again air can be considered the active material and the same issue as to product by process claim⁵~~2~~ applies as discussed above.

9. Claims 9 and 18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Frease.

Frease teaches a spiral wound member which contains channels (13-3) for claim 9. Layer (11-1) can be considered the additional layer recited in claim 18. Refer to Fig. Nos. 1 and 3. The same issues as to air in the channels and product by process claims are reiterated.

10. Claim 10 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either Aptel et al or Okamoto et al.

Both references teach a member with channels used to filter materials. Refer to the Abstract and column 5, lines 24-34 in Okamoto et al. Refer to Fig No. 2 along with column 2, lines 19-50 and column 4, lines 19-24 in Aptel et al.

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The foreign references cited by the applicant have been considered as to the extent discussed there by since no English translations have been included.

11. Any inquiry concerning this communication should be directed to D. Loney at telephone number 703-308-2416.

D. Loney/mn
April 11, 2003

A handwritten signature in black ink, appearing to read "Donald J. Loney", with a stylized flourish at the end.

DONALD J. LONEY
PRIMARY EXAMINER